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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/903,433	07/11/2001	Stephen L. Galbraith	043210-1396-00	8922
23409	7590	06/04/2004	EXAMINER	
MICHAEL BEST & FRIEDRICH, LLP 100 E WISCONSIN AVENUE MILWAUKEE, WI 53202				ROYAL, PAUL
ART UNIT		PAPER NUMBER		
		3611		

DATE MAILED: 06/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/903,433	GALBRAITH ET AL.
	Examiner	Art Unit
	Paul Royal	3611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 23 February 2004.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 17-20 is/are allowed.
- 6) Claim(s) 1,2,4,9 and 10 is/are rejected.
- 7) Claim(s) 3, 5-8, 11-16 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date, _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The amendment filed on 23 February 2004 has been entered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 4, and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Galbraith et al. (US 6,390,220).

Galbraith et al. teaches a motorcycle comprising:

a frame (12), including a seat pan portion (30);

a rear wheel (14) rotatably interconnected with a rear portion of said frame and supporting a rear end of said motorcycle;

a mounting member (20) coupled to said frame (12) on top of the rear fender (16), the mounting member (20) including a luggage rack mounting portion (24), which extends rearward, the mounting member further having a top surface facing away from said frame, and a bottom surface facing toward said frame, the mounting member further including a backrest mounting portion (23);

a seat (15) mounted over a portion of said top surface of said mounting member (20) to sandwich a portion of said mounting member (20) between said seat (15) and

said frame (12), wherein the seat is not positioned over the luggage rack mounting portion;

a luggage rack (18) mounted to said luggage rack mounting portion (24) of said mounting member (20) wherein the luggage rack (18) extends rearwardly of said mounting member (20) in a generally cantilever fashion;

a backrest mounted to the mounting portion of the mounting member;

the rear fender (16) disposed over said rear wheel and extending rearwardly of said seat, said rear fender having an arcuate top surface, wherein said bottom surface of said mounting member has a curvature substantially matching said arcuate top surface of said rear fender, and wherein substantially the entire bottom surface of said mounting member is in continuous contact with said arcuate top surface of said rear fender.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Galbraith et al., as applied to claim 1, in view of Nakamura (US 4,174,796).

Galbraith et al., as applied to claim 1, teaches the claimed limitations except herein the luggage rack mounting portion of said mounting member includes a plurality of stiffening ribs within the cavity.

Nakamura teaches a rear carrier device for a motorcycle including a luggage rack (40) having a plurality of stiffening ribs (58), the ribs increasing the overall moment of inertia of said mounting member, to provide a carrier which does not interfere with the mounting and dismounting of the rider.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the luggage rack of Galbraith et al., as applied to claim 1, to include the luggage rack having a plurality of stiffening ribs (58), the ribs increasing the overall moment of inertia of said mounting member, to provide a carrier which does not interfere with the mounting and dismounting of the rider.

Allowable Subject Matter

4. Claims 3, 5-8, 11-16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

5. The following is a statement of reasons for the indication of allowable subject matter: The prior art does not show a motorcycle as disclosed having the recited curvature, side surfaces, first and second arms, and stiffening ribs as claimed.

For claims 5 and 11, the prior art does not show a motorcycle as disclosed having the backrest mounting portion formed in the side surface of the mounting member.

6. 17-20 are allowed.

7. The following is an examiner's statement of reasons for allowance:

For claim 17, the prior art does not show a motorcycle as disclosed having the seat pan portion as claimed.

For claims 18-20, the prior art does not show a motorcycle as disclosed having the Y shaped mounting member including the recited curvatures.

Response to Arguments

8. Applicant's arguments filed 23 February 2004 have been fully considered but they are only partially persuasive.

Applicant argues that one of ordinary skill in the art would understand that a seat, as claimed in claims 1 and 11, includes a seat cushion and structural saddle. The Examiner does not agree because the structural saddle of Hanagan performs the same function as the mounting member of the instant invention where they both couple the seat to the frame.

The Examiner agrees that Hanagan does not teach the claim limitations as presented in the 23 February 2004 amendment.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Royal whose telephone number is 703-308-8570. The examiner can normally be reached on 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley D. Morris can be reached on 703-308-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Paul Royal
Examiner
Art Unit 3611

P. Royal
May 25, 2004


Lesley D. Morris
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600